

REMARKS

Applicants initially wish to thank Examiner Kim for the interview with co-inventor Mr. James McErlean and the undersigned (Applicants' representatives) on September 24, 2003. During that interview, the Office Action dated December 10, 2002 was discussed, and arguments were presented regarding the distinguishing features of the present invention vis-à-vis U.S. Patent No. 5,208,762 to Charhut et al. in view of U.S. Patent No. 5,463,840 to Bailer and U.S. Patent No. 4,672,553 to Goldberg. In the Interview Summary, Examiner Kim agreed to give further consideration to the claims in view of the cited art upon receipt of our (this) response to the aforementioned Action.

In the Action dated September 16, 2003, the Examiner indicated that the claims do not comply with 37 CFR 1.173(b), and that a supplemental paper correctly amending the reissue application is required. Applicants submit that the attached claim listing comports with 37 CFR 1.173(b).

Applicants incorporate herein by reference the remarks contained in Applicants' responses filed on August 11, 2003, September 30, 2002, and July 29, 2002. Applicants submit that the combination of elements and/or steps recited in each presently pending claim, when interpreted as a whole, is patentable over any combination of Charhut, Bailer and Goldberg.

Applicants appreciate the Examiner's indication of allowable subject matter of claims 5, 17-24, 32-35, 45-48, 60-64, 77-80, 116-120, 148, 153-155, and 163-165. Although the Examiner erroneously indicated that claim 149 is rejected, it is clearly allowed since it depends from allowed independent claim 148. These claims have been placed in allowable format. In particular:

The subject matter of claim 5 has been incorporated into claim 4. Accordingly, claim 5 has been canceled.

The subject matter of claim 17 has been incorporated into claim 16. Accordingly, claim 17 has been canceled.

The subject matter of claim 32 has been incorporated into claim 30. Accordingly, claim 32 has been canceled.

The subject matter of claim 45 has been incorporated into claim 44. Accordingly, claim 45 has been canceled.

The subject matter of claim 60 has been incorporated into claim 58. Accordingly, claim 60 has been canceled.

The subject matter of claim 77 has been incorporated into claim 75. Accordingly, claim 77 has been canceled.

The subject matter of claims 116 and 117 have been incorporated into claim 114. Accordingly, claim 116 has been canceled.

The subject matter of claim 163 has been incorporated into claim 156. Accordingly, claim 163 has been canceled.

Claims 91-113, 124-147, and 150-152, have also been canceled.

Claims 166-218 have been added in this amendment. Support for claims 166-218 is found throughout U.S. Patent No. 5,771,657, and particularly at col. 1, line 55 – col. 16, line 8, and Figures 1-9.

With regard to claims 1-15, originally issued as part of U.S. Patent No. 5,771,657, claim 1 has been amended to now recite that the order consolidation means comprises a bagger. Support is found at least on Figure 7 of U.S. Patent No. 5,771,657, and the corresponding specification description. The amendments to claim 2 are clarifying. The amendments to claim 3 are broadening amendments, removing certain limitations from these claims.

Claim 4 has been amended to incorporate the allowable subject matter of claim 5.

The amendments to claim 8 remove the “scheduled locations” limitations.

The amendments to claim 10 remove the “assigned locations” limitations, and add “means for removing” and “means for packing” limitations. Support is found at least on Figure 7 of U.S. Patent No. 5,771,657, and the corresponding specification description.

Claim 11 has been amended to recite means for packing. Support is found at least on Figure 7 of U.S. Patent No. 5,771,657, and the corresponding specification description.

Claims 41 and 88 have been amended to recite that the at least one dispensing machine dispenses each prescription into “at least one” separate bottle for each prescription. Support is found at least at column 4, lines 43-45 of U.S. Patent No. 5,771,657.

The amendments made to claims 1-15 in Applicants’ response filed on September 30, 2002, are described therein.

A. Claims 1-3

Independent claim 1 recites a combination of features directed to an automatic prescription filling and dispensing system. As recited by claim 1, the system comprises, *inter alia*, “one or more pill dispensing machines to automatically count out and dispense pills into two or more prescription bottles in accordance with prescription orders.” The system also comprises “means to print literature packs **customized to said prescription orders.**” In addition, the system comprises an “bagger that present a shipping container for each prescription order.” Finally, claim 1 recites that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack.” This combination of features recited in claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without conceding that any reference discloses or suggests any of the elements recited in claim 1, each reference absolutely fails to teach or suggest, in addition, at least the feature of printing a literature pack customized to a prescription order, or the feature of a literature pack being inserted “separately” from a bottle for a prescription order. In fact, none of these references disclose *anything* with regard to a literature pack being associated with a bottle of a prescription order. In this regard, Bailer discloses a generic literature package being inserted into a pocket or holder (see, e.g., col. 4, lines 21-23), and has nothing to do with printing literature packages, let alone printing “literature packs customized to said prescription orders,” as recited in the claimed invention. In this regard, Charhut also does not teach or suggest that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack.” Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 2-3 are not only allowable by virtue of their dependency from independent claim 1, but also because of additional features they recite. Claim 3, for example, recites that “the bottle identifiers are applied to said prescription bottles

prior to dispensing pharmaceuticals into the bottles,” which is not taught or suggested by Charhut, Bailer or Goldberg. In fact, Charhut teaches away from the claimed invention in this regard insofar as Charhut teaches that vials are labeled “during or immediately following filling.” (col. 4, lines 1-4).

In view of the above, Applicants submit that the combination of features recited in each of claims 1-3 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 1-3 be passed to issue.

B. Claims 8 and 9

Independent claim 8 recites a combination of features directed to a system for assembling prescription orders. As recited by claim 8, the system comprises, *inter alia*, “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles.” The system also comprises “means for assembling a plurality of carriers, and means for removing the prescription bottles of said order from the carriers and packing the bottles of said order in a container with a corresponding customized literature pack, the customized literature pack and each prescription bottle having an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into a shipping container with the corresponding customized literature pack.”

This combination of features of independent claim 8, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without conceding that Charhut, Bailer or Goldberg, disclose or suggest any of the elements recited in claim 8, each reference absolutely fails to teach or suggest, in addition, at least a prescription dispensing system having “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles.” In this regard, and as noted above, the Examiner’s assertion that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes Charhut, Bailer or Goldberg, alone or in combination, teach or suggest “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest that the customized literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into a shipping container with the corresponding **customized** literature pack.” Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claim 9 is not only allowable by virtue of its dependency from independent claim 8, but also because of additional features it recites. Claim 9 recites, *inter alia*, “means for printing the customized literature for said order.” Charhut, Bailer or Goldberg, alone or in combination, do not disclose one or more printers 31 integrated with the system, as shown in Figure 2 of U.S. Patent No. 5,771,657.

In view of the above, Applicants submit that the combination of features recited in each of claims 8 and 9 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 8 and 9 be passed to issue.

C. Claims 10 and 11

Independent claim 10 recites a combination of features directed to a system for sorting prescriptions by prescription order. As recited by claim 10, the system comprises, *inter alia*, “a carrier having the capability of receiving a multiplicity of prescription bottles.” The system also comprises “means responsive to a prescription of an order to provide one or more prescription bottles filled with pharmaceuticals.” The system comprises “an order consolidation and packing station comprising means for receiving said carrier, means for removing said one or more prescription bottles from said carrier, and means for packing said one or more prescription bottles and a corresponding customized literature pack in a container.” Finally, claim 10 recites that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into the shipping container with the corresponding customized literature pack.”

This combination of features of independent claim 10, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without

conceding that Charhut, Bailer or Goldberg disclose or suggest any of the elements recited in claim 10, each reference absolutely fails to teach or suggest at least the feature of “a carrier having the capability of receiving a multiplicity of prescription bottles.” In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes Charhut, Bailer or Goldberg, alone or in combination, teach or suggest “a carrier having the capability of receiving a multiplicity of prescription bottle” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest that the customized literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into the shipping container with the corresponding **customized** literature pack.” Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claim 11 is not only allowable by virtue of its dependency from independent claim 10, but also because of additional features it recites. Claim 11 recites, *inter alia*, “means for printing the customized literature pack corresponding to said order.” As noted above, Charhut, Bailer or Goldberg, alone or in combination, do not disclose one or more printers 31 integrated with the system, as shown in Figure 2 of U.S. 5,771,657.

In view of the above, Applicants submit that the combination of features recited in each of claims 10 and 11 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 10 and 11 be passed to issue.

D. Claims 12-15

Independent claim 12 recites a combination of features directed to method of sorting prescription bottles by prescription order. As recited in claim 12, the method comprises the step of, *inter alia*, “placing the one or more prescription bottles of each order in carriers, each carrier having a multiplicity of locations to receive prescription bottles.” The method also comprises the step of “removing the one or more prescription bottles from the carriers in accordance with said record and placing the one or more prescription bottles and a corresponding customized literature pack of each order in a container.” In addition, the method comprises the steps of “identifying one or more prescription bottles corresponding to each order,” and “maintaining a record for each order of the identification of the carriers containing the one or more prescription bottles of each order.” This combination of features of independent claim 12, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of steps recited above. Without conceding that Charhut, Bailer or Goldberg disclose or suggest any of the steps recited in claim 12, each reference absolutely fails to teach or suggest at least the step of “placing the one or more prescription bottles of each order in carriers, each carrier having a multiplicity of locations to receive prescription bottles,” as recited in the claimed invention. In fact, none of these references disclose *anything* with regard to carriers containing prescription bottles. In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes Charhut, Bailer or Goldberg, alone or in combination, teach or suggest the step of “placing the one or more prescription bottles of each order in carriers, each carrier having a multiplicity of locations to receive prescription bottles” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such step and/or carriers are disclosed.

In addition, Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest “placing the one or more prescription bottles and a corresponding **customized** literature pack of each order in a container.” Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 13-15 are not only allowable by virtue of their dependency from independent claim 12, but also because of additional features they recite. Claims 14 recites that the “identifier is applied to each of the one or more bottles prior to filling said prescription bottles with pills,” which is not taught or suggested by Charhut, Bailer or Goldberg, alone or in combination.

In view of the above, Applicants submit that the combination of features recited in each of claims 12-15 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 12-15 be passed to issue.

E. Newly Added Claims 166-218

Claims 166-218 have been added in this amendment, and are believed to be patentable in view of any combination of Charhut, Bailer and Goldberg. Support for claims 166-218 is found throughout U.S. Patent No. 5,771,657, and particularly at col. 1, line 55 – col. 16, line 8, and Figures 1-9.

Conclusion

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, that is patentable. Applicants have emphasized certain features in the claims as clearly not present in the claims, as discussed above. However, Applicants do not concede that other features in the claims are also not missing in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why each of the claims described above are distinguishable over the cited prior art.

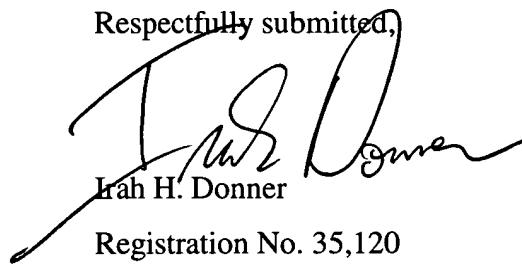
For all the reasons advanced above, issuance of a Notice of Allowance is respectfully requested.

Authorization

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,



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